



# UNITED STATES PATENT AND TRADEMARK OFFICE

*SW*  
UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/647,686	08/25/2003	Bobby Hu	CFP-1856 (15722-570)	2908
7590	11/04/2004		EXAMINER	
Alan, D. Kamrath NIKOLAI & MERSEREAU, P.A., 820 INTERNATIONAL CENTRE 900 SECOND AVENUE SOUTH MINNEAPOLIS, MN 55402-3325			GEHMAN, BRYON P	
			ART UNIT	PAPER NUMBER
			3728	

DATE MAILED: 11/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/647,686	HU, BOBBY
	<b>Examiner</b> Bryon P. Gehman	<b>Art Unit</b> 3728

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### **Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 24 March 2004.

2a)  This action is **FINAL**.                            2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## **Disposition of Claims**

4)  Claim(s) 1-20 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5)  Claim(s) \_\_\_\_\_ is/are allowed.  
6)  Claim(s) 1-20 is/are rejected.  
7)  Claim(s) 3-4 and 17 is/are objected to.  
8)  Claim(s) 1-20 are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All    b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date .  
4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_ .  
5)  Notice of Informal Patent Application (PTO-152)  
6)  Other: \_\_\_\_ .

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 1, line 6, since the rotatable member is not included as part of the device being claimed, there is insufficient structure provide for the frictional retaining member actually "exerting a frictional force to any rotatable member as is claimed. See also claim 9, lines 6-7 and claim 13, lines 7-8 where frictional force is defined absent sufficient structure (the rotatable member being included) for the force to occur. In line 10, "a ratcheting direction" lacks antecedent basis for what such comprises, as no ratcheting has been defined.

In claim 2, lines 4-5, since the rotatable member has not been included as part of the claimed device, there is insufficient antecedent basis for the frictional retaining member "extending across a portion .... of the rotatable member.

In claim 5, line 4, "the respective through-hole of the body" lacks antecedent basis for one such through-hole, and additionally for what "respective" is referring to.

In claim 7, line 2, "the first side" lacks antecedent basis. In line 4, there is no basis for "respective snapping member" as to what makes it "respective" to anything. Similarly, in line 5, "respective hole" lacks basis for respect to what. See also claim 8, lines 5 and 6.

In claim 16, lines 1-2, "the first side of the body" lacks antecedent basis.

In claim 17, line 1, "the recessed portion" lacks antecedent basis from parent claims 3, 2 and 1.

In claim 19, line 1, "the integral stop" lacks antecedent basis from claim 1.

In claim 20, absent the rotatable member as a component of the device, the functional recitation cannot be obtained. Also, the ratcheting direction again lacks antecedent basis.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1 and 11-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Theros (4,872,551). Claims 1-2, 5-6, 8, 15-16 and 18-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Kao (5,906,350). Claims 1, 9-11, 15-16 and 18-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Ling (5,988,381). Claims 1-2, 15-16 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Lee (Figures 6, 8 and 9)(6,164,463). Claims 1, 11-16 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Vasudeva (6,241,092). Each discloses a tool try-on device (the nomenclature not providing any structure) comprising a body (32, 34; 61; 10; 20; 1 and 12; respectively) and a frictional retaining member (48 or 66; 20; 20; 30; 18) mounted to the body to define a compartment, the frictional retaining member

capable of exerting a frictional force to an outer surface of a rotatable member (26; driving head 81; driving head of tool 50, see Figure 7; grippable arms of the shown tools; 11) of a tool.

As to claim 2, Kao and Lee disclose two through-holes (15, 15; 200, 200) with the frictional retaining member extending through the holes (via elements 27; via elements 33).

As to claim 5, Kao discloses snapping members (27).

As to claim 6, Kao discloses an arcuate groove 9 (at 68).

As to claim 8, Kao discloses the body including two through-holes (13, 13), the frictional retaining member including holes (250, 250) with a snapping member (24, 24) engaging the paired holes.

As to claims 9 and 10, Ling discloses the body (10) including a through-hole (13) and the frictional retaining member including an integrally formed end (at 30) and a second end having a snapping member (22).

As to claims 11 and 12, Theros and Vasudeva each disclose the frictional retaining member (66; 18) including two ends (66 and 66; 18 in element 12 and 18 in element 14) and arcuate grooves therein.

As to claims 13 and 14, Vasudeva discloses the body including two halves (12, 14) each having a recessed portion (18, 18) with the frictional retaining member being mounted around the recessed portions, the frictional retaining member including a first end with a hole (24) and a second end having a toothed side (22).

As to claim 15, each discloses a tool-holding section (38; 26; 21; inside 31; 15).

As to claims 16 and 18, each discloses a stop (48 or 50; top of 20; top of 20; 30; 22, 24).

As to claim 19, Kao and Ling disclose portions of the frictional member being L-shaped.

As to claim 20, the reference to an imaginary tool fails to structurally distinguish the claimed device absent the tool as claimed.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kao. To locate the snapping members on the body and the frictional retaining member having holes therein would have been an obvious reversal of the location of the corresponding parts (1515 and 27, 27) of Kao.

7. This application contains claims directed to the following patentably distinct species of the claimed invention: I) Figs. 1-4; II) Fig. 5; III) Figs. 6-9; IV) Fig. 10; V) Figs. 11-14; VI) Fig. 15; VII) Fig. 16; VIII) Fig. 17; IX) Fig. 18; X) Fig. 19; XI) Fig. 20; XII) Fig. 21; XIII) Fig. 22; and XIV) Fig. 23.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no allowable claim is generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

8. Claim 3 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the

limitations of the base claim and any intervening claims. Dependent claims 4 and 17 would also then be allowable.

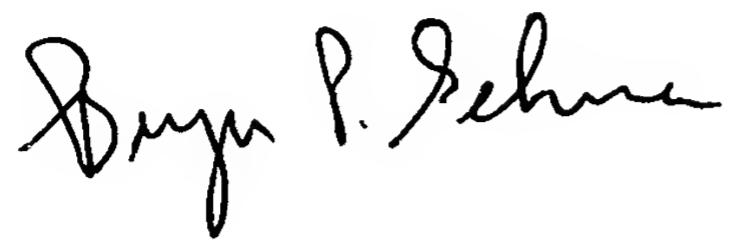
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bryon P. Gehman whose telephone number is presently (703) 605-1174 and effective November 9, 2004, becomes (571) 272-4555. The examiner can normally be reached on Monday through Wednesday from 5:30am to 6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu, can be reached presently on (703) 308-2672 and after November 9, 2004 on (571) 272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-4555 effective November 8, 2004.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Application/Control Number: 10/647,686  
Art Unit: 3728

Page 8



Bryon P. Gehman  
Primary Examiner  
Art Unit 3728

BPGB